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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,289	03/25/2004	Akinori Iwase	016907-1600	5194
23428 7590 10/02/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER HUNTSINGER, PETER K				
ART UNIT		PAPER NUMBER		
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10/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,289

Applicant(s)

IWASE ET AL.

Examiner

Peter K. Huntsinger

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/11/09 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 51-68 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claims 53, 59 and 65 are objected to because of the following informalities:

In claim 53, replace line 3 with "computer having a window providing a check button adapted to designate the a pre-print". Claims 59 and 65 require similar corrections. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 51, 52, 57, 58, 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No. Yoneda 5,222,157 in view of Telle Patent 5,555,099.

Referring to **claim 51**, Yoneda '157 discloses an image forming apparatus comprising:

receiving section (col. 4, lines 3-11, system bus 6 of Fig. 1) configured to receive a plurality of pages of image data transmitted through a communication line (col. 27, lines 26-34, a document recorded is retrieved in the retrieving operation) and to receive a partial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

storage section configured to store the image data and the partial print request-signal, both received at the receiving section (col. 4, lines 26-29, memory section 3 of Fig. 1);

first printing section configured to perform a trial print on a paper sheet, in response to the partial print request signal stored in the storage section (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

second printing section configured to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction after the first printing section has printed the part of the image data (see Fig. 11, the document can be printed

and then printed again), said all-page print instruction demanding that the image data be printed in a specific fashion (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing an image indicating trial printed data.

Telle '099 discloses performing trial printing which a part of the image data and an image indicating that the trial printed data is a part of the received plurality of pages of image data (col. 9, lines 47-49, page number identifying indicia is provided on proof set of a multipage document to be printed as a print job).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print page number identifying indicia on a proof set. The motivation for doing so would have been to provide a greater ability for a user to review a proof set for mistakes before all data is printed. Therefore, it would have been obvious to combine Telle '099 with Yoneda '157 to obtain the invention as specified in claim 51.

Referring to **claims 52, 58 and 64**, Yoneda '157 discloses wherein the second printing section receives the all-page print instruction from a user through a control panel provided on the image forming apparatus (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12 includes the all setting which causes all the contents of the corresponding document to be printed).

Referring to **claims 57 and 63**, Yoneda '157 discloses an image forming apparatus comprising:

receiving section (col. 4, lines 3-11, system bus 6 of Fig. 1) configured to receive a plurality of pages of image data transmitted through a communication line (col. 27, lines 26-34, a document recorded is retrieved in the retrieving operation) and to receive a partial print request signal requesting that only a part of the image data be printed (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

first printing section configured to perform a trial print on a paper sheet, in response to the partial print request signal stored in the storage section (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

second printing section configured to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction after the first printing section has printed the part of the image data (see Fig. 11, the document can be printed and then printed again), said all-page print instruction demanding that the image data be printed in a specific fashion (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing an image indicating trial printed data.

Telle '099 discloses performing trial printing which a part of the image data and an image indicating that the trial printed data is a part of the received plurality of pages of image data (col. 9, lines 47-49, page number identifying indicia is provided on proof set of a multipage document to be printed as a print job).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print page number identifying indicia on a proof set. The motivation for doing so would have been to provide a greater ability for a user to review a proof set for mistakes before all data is printed. Therefore, it would have been obvious to combine Telle '099 with Yoneda '157 to obtain the invention as specified in claim 57.

6. Claims 53, 54, 59, 60, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Telle Patent 5,555,099 as applied to claims 51, 57 and 63 above, in further view of Wood Patent No. 6,453,127.

Referring to **claims 53, 59 and 65**, Yoneda '157 discloses wherein the image forming apparatus is adapted to receive the partial print request signal from an image forming apparatus having a window providing a check button adapted to designate a pre-print display mode of trial printing (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12 the partial setting which allows the user to select partial printing of certain pages of the document).

Yoneda '157 does not disclose expressly receiving the print request from a personal computer.

Wood '127 discloses receiving the print request from a personal computer (col. 2, lines 5-17, user interface allows the computer to communicate print job to copier);

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to receive a print command from a PC. The motivation for doing so would have been to enable printing computer based data. Therefore, it would have

been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 53.

Referring to **claims 54, 60 and 66**, Yoneda '157 discloses the second printing section is configured to print all pages of image data, but does not disclose transferring data representing the specific fashion to a data processing device.

Wood '127 discloses a transfer section configured to transfer data representing the specific fashion to a data processing device which has transmitted the image data to the image forming apparatus through the communication line, after printing image data (col. 6, lines 18-34, the UIS provides data through the thread and socket connection to the work station 11 for the next user interface screen of Fig. 4).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a printer to control a printer from a PC. The motivation for doing so would have been to enable printing computer based data. Therefore, it would have been obvious to combine Wood '127 with Yoneda '157 to obtain the invention as specified in claim 54.

7. Claims 55, 56, 61, 62, 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda Patent 5,222,157 and Telle Patent 5,555,099 as applied to claims 51, 57 and 63 above, in further view of Silverbrook Patent 5,984,446.

Referring to **claims 55, 61 and 67**, Yoneda '157 discloses wherein: the first printing section is adapted to print the part of the image data stored in the storage

section (col. 17-18, lines 63-68, 1-7, the partial setting of Fig. 12 allows the user to select partial printing of certain pages of the document); and

the second printing section is adapted to print all pages of the image data stored in the storage section, upon receiving an all-page print instruction from the user through the control panel provided on the image forming apparatus, after the first printing section has printed the part of the image data (col. 17-18, lines 63-68, 1-7, the all setting of Fig. 12 causes [i.e. demands] all the contents of the corresponding document to be printed).

Yoneda '157 does not disclose expressly printing in color.

Silverbrook '446 discloses printing in color (col. 6, lines 16-32, color copiers are used).

At the time of the invention, it would have obvious to a person of ordinary skill in the art for a copier to print in color. The motivation for doing so would have been to enable printing more expressive documents. Therefore, it would have been obvious to combine Silverbrook '446 with Yoneda '157 to obtain the invention as specified in claim 55.

Referring to **claims 56, 62 and 68**, Yoneda '157 discloses wherein: the first printing section is adapted to print the part of the image data in response to the partial print request signal stored in the storage section, upon receiving a partial print instruction from the user through the control panel provided on the image forming apparatus printing (col. 17-18, lines 63-68, 1-7, condition display panel 117 of Fig. 12

the partial setting which allows the user to select partial printing of certain pages of the document).

Silverbrook '446 discloses a color print instruction (col. 6, lines 16-32, color copiers are used).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625